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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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#46

In re Application of
Wayne A. Marasco et al
Serial No.: 08/822,033
Filed: March 24, 1997
Attorney Docket No.: 43471-RCE2

: PETITION DECISION

This is a decision on the petition under 37 CFR 1.181, filed February 19, 2003, requesting withdrawal of the finality of an Office action.

BACKGROUND

A review of the pertinent portion of the file history shows that the examiner mailed a Final Office action to applicants on May 28, 2002. The examiner rejected claims 1, 3-5 and 7-16 under 35 U.S.C. 103(a) as unpatentable over Beug et al, Chaudhary et al and Wu et al. Claim 6 was rejected under 35 U.S.C. 103(a) as unpatentable over Beug et al in view of Chaudhary et al and Wu et al further in view of Ryder et al. In response applicants filed a proposed amendment under 37 CFR 1.116 on October 28, 2002 in which claim 1 was proposed to be amended. The examiner refused entry of the amendment in an Advisory Action mailed to applicants on November 18, 2002, indicating that the proposed new limitations would "require a new search and further consideration". In view thereof, applicants filed a Request for Continued Examination (RCE) on November 26, 2002, presenting the same amendment to claim 1 as presented in the unentered amendment which was now entered.

The examiner then mailed a new Final Office action to applicants on February 11, 2003, maintaining the rejections of record and addressing the new limitation presented. Applicants filed this petition on February 19, 2003, requesting withdrawal of the finality of the Office action on the basis that it is improper.

DISCUSSION

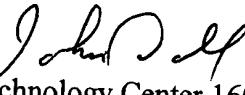
Applicants refer specifically to M.P.E.P. 706.07(h) and 706.07(b) regarding when an Office action is properly made Final. Therein it clearly states that when an amendment after final rejection is proposed and denied entry as raising new issues and the same amendment is then entered as a consequence of a RCE filing, the next Office action cannot be a Final Office action. This standard holds whether the same rejection is set forth or not since the examiner must consider the new issues and allow applicant at least one opportunity to reply to any new arguments presented.

DECISION

Applicants' petition is **GRANTED**.

The finality of the last Office action is withdrawn. Applicants remain under obligation to respond to the last Office action within the time period set therein or as may be extended under 37 CFR 1.136(a). The reply will be entered and considered under 37 CFR 1.111.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

John Doll 
Director, Technology Center 1600